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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,075	11/01/1999	JEAN MARC NICOLAI	1948-4631	6316

7590 12/30/2003
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

TUGBANG, ANTHONY D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,075

Applicant(s)

NICOLAI ET AL. *cn*

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed 10/9/03 (Paper No. 23) has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 4, 5 and 7 rejected under 35 U.S.C. 102(b) as being anticipated by Tuttle 5,601,941.

Tuttle discloses a method of producing an assembly comprising: forming a gutter (recess 36) on a metal substrate (housing 12) by stamping (see col. 4, lines 14-18); mounting a printed circuit electronics card (contact trace 50) onto a bottom surface of the metal substrate 12 and adjacent or next to the gutter (see Fig. 3); positioning a metal screening cover 14 having an edge including a tab (annular portion 30) so that the tab rests substantially within the gutter; and crimping the metal substrate to secure the tab of the metal screening cover onto the metal substrate (see col. 4, lines 43-47).

With respect to the "wherein..." clause (last 2 lines of Claim 4), it is noted that these limitations have not been any patentable weight as these limitations are directed to a future event of electromagnetically screening and do not affect, or do not patentably further limit, the present event of the manufacturing method or the present tense of the recited steps of forming, mounting, positioning, and crimping.

With respect to Claim 7, the gasket 16 of Tuttle can be broadly read as another tab that is crimped with the tab 30. Thus, there are a plurality of tabs 16, 30 that can be said to be crimped.

Response to Arguments

4. The applicants' arguments filed 10/9/03 (Paper No. 23) have been fully considered, however, they have not been deemed to be found as persuasive.

In regards to the merits of Tuttle, the applicants' believe that Tuttle does not teach "crimping the metal substrate to secure the tab of the metal screening cover onto the metal substrate, wherein the metal screening cover is positioned to electromagnetically screen the printed circuit electronics card" (lines 9-11 of Claim 4).

The examiner most respectfully traverses for the following reasons. While the step of crimping is self explanatory from the rejection set forth above, the applicants' appear to place a great deal of emphasis on the "wherein..." clause (last 2 lines of Claim 4) as the applicants' appear to be arguing how this wherein clause is somehow interconnected with the step of crimping. The examiner notes that the limitations directed to the wherein clause do not affect the claimed manufacturing method because the claimed method steps as recited (in Claim 4) do not require any electromagnetic screening or do not require how any electromagnetic screening occurs. The applicants' even assert, "...*the printed circuit electronics card is electromagnetically screened **after** it is mounted onto the metal substrate...*" (page 7, lines 13-15, of the amendment filed 10/9/03). So if electromagnetic screening occurs after crimping, how does that have any impact on the step of crimping when it occurs? Or even a bigger question is, how does electromagnetic screening affect any of the other method steps at the time each is

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occurring? The examiner's position is that electromagnetic screening in no way affects the method steps as recited in at least Claim 4.

Applicants' further argue that the printed circuit card (contact trace 50) of Tuttle is not positioned between the housing and the cover when crimped together or is not adjacent to the cover. The examiner again traverses in that the term "adjacent" is a very broad and relative term and certainly the printed circuit card (contact trace 50) of Tuttle is adjacent, i.e. next to, the gutter (recess 36) of Tuttle. The limitations of the printed circuit card (trace 50) being positioned *between* the housing and the cover is nowhere recited in the rejected claims and it appears that the applicants' are arguing more specifically than that which is claimed. Limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly, the examiner maintains the rejection of Tuttle as applied to Claims 4, 5 and 7.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 9:00 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


A. Dexter Tugbang
Primary Examiner
Art Unit 3729

December 23, 2003